UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,584	03/25/2004	Rhonda L. Childress	AUS920040116US1	7111

35525   7590   05/31/2007
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ART UNIT	PAPER NUMBER
2113	

MAIL DATE	DELIVERY MODE
05/31/2007	PAPER

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PTOL-90A (Rev. 04/07)

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/809,584
Filing Date: March 25, 2004
Appellant(s): CHILDRESS ET AL.

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Technology Center 2100

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<u>For Appellant</u>

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/11/07 appealing from the Office action mailed 11/13/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

WO 03/098449 A1   HOLT et al.   11-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 19-20 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. The disclosure contains intrinsic evidence that

the article of manufacture (i.e. the claimed computer program product) is intended to

cover transmission links, light waves, radio frequency transmission, etc. (see

Specification page 16 line 28-page 17 line 4). The claims therefore fail to fall within a

statutory category. Light waves, radio frequency transmissions, etc. are merely forms of

energy and are not a machine, process, manufacture or composition of matter. In

addition, such computer readable media is not structurally and functionally

interconnected with the software in such a manner to enable any usefulness to be

realized.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-20 rejected under 35 U.S.C. 102(a) as being anticipated by Holt et al.

(WO 03/098449 A1).

Regarding claim 1:

Holt teaches:

a plurality of notification units (paragraph 0017 lines 5-7);

a network coupled to said plurality of notification units, said network operable to

determine whether each notification unit of said plurality of notification units is available

to receive system management information (Fig. 1 and paragraph 0030); and

a plurality of management units coupled to said network (Fig. 3), at least one

management unit of said plurality of management units configured to perform the steps:

generate said system management information (paragraph 0017 lines 1-3);

determine an identity of an intended recipient for said system management

information (paragraph 0024 lines 10-12);

associate said identity with at least one notification unit of said plurality of notification units (paragraph 0017 lines 5-7 and paragraph 0030 lines 5-8);

determine whether said at least one notification unit is available to receive said system management information (paragraph 0030); and

send said system management information to said at least one notification unit via a notification handler if said at least one notification unit is available to receive said system management information (paragraph 0017).

Regarding claim 2:

Holt teaches:

wherein said notification handler converts said system management information into a form that is appropriate for the notification unit (paragraphs 0030-0033 – the notification can be sent in any format (i.e. instant message, email, etc.) depending on the appropriate format for the notification unit the message is sent to).

Regarding claim 3:

Holt teaches:

wherein said network comprises a presence network (paragraph 0015).

Regarding claim 4:

Holt teaches:

wherein said network comprises an instant messaging network (paragraph

0030).

Regarding claim 5:

Holt teaches:

wherein said at least one notification unit comprises an instant messaging client

associated with said intended recipient (paragraph 0030).

Regarding claim 6:

Holt teaches:

wherein said at least one management unit comprises at least one of a

management agent and a managed resource (Fig. 3 – the various servers are clearly

equivalent to management agents or managed resources).

Regarding claim 7:

Holt teaches:

wherein said system management information comprises event information or

notification information (paragraph 0017 lines 3-5).

Regarding claim 8:

Holt teaches:

wherein said intended recipient comprises at least one of an entity, party and

person having a responsibility for responding to said system management information

(paragraphs 0004 and 0017).

Regarding claim 9:

Holt teaches:

wherein the operation to determine said identity comprises an operation to

access an on-call list of responsible entities, parties or persons (paragraph 0024).

Regarding claims 10-18:

The claims are rejected as the methods of using the systems of claims 1-9.

Regarding claims 19-20:

The claims are rejected as the program products causing the methods of claims

10-11 to be performed.

(10) Response to Argument

Applicant argues, on pages 10-12 :

" *No basis exists for holding a computer program product claim as non-statutory*

because the computer readable medium may be allegedly intangible....Thus, the

transmission-type media, or carrier waves and signals, are "tangible" despite the

allegation made in the Final Office Action to the contrary. Consequently, even if there

were some MPEP requirement that the media be "tangible," which there is not, claim 19,

as recited, would still meet that requirement."

The examiner respectfully disagrees. The computer readable medium of the

claim is intended to cover transmission type media such as, for example, light waves or

radio frequency transmissions. These forms of transmission type media are nothing

more than forms of energy and thus do not fall into one of the four statutory categories

of patentable subject matter. Further, these types of media do not contain the structural

and functional interrelationship with the instructions necessary to allow the functionality

and usefulness of the instructions to be realized.

Applicant argues, on pages 12-16 :

" The specification teaches that the system management information is data

regarding the occurrence of an event, such as a critical failure of a system component

or notification relating to a critical failure of a system component....In other words, a

problem that Appellants were endeavoring to solve at the time of invention was the

efficient dissemination of system management information with regard to the critical

failure of system components....Holt does not teach generating and sending "system

management information" as recited in claim 1."

The examiner respectfully disagrees. As was previous explained in two interviews and the Final Rejection, system management information is clearly defined in applicant's specification to include notification or event information (Specification page 5, lines 21-24). The notification message of Holt clearly meets this definition of system management information.

Applicant appears to believe that system management information should limited to information concerning a critical failure of a system component. Such a limitation, however, does not ever appear in the claims. If applicant would like such a limitation considered, the examiner suggests adding such a limitation to the language of the claims. It would appear clear that applicant intends to gain coverage for the broad interpretation of system management information due to the fact that applicant has not explicitly defined the term as covering only information regarding critical failures of · system components and has instead included, by way of example, "notification information, etc." in the description of system management information cited by both the examiner and applicant in applicant's own arguments. The claims, as currently written, would clearly give applicant coverage for, not only critical failure information as applicant suggests, but also for any type of information that falls under the broad scope of event information or notification information and are thus properly rejected by the notification information contained in Holt.

To the extent that applicant's specification provides a guiding definition for the broadest reasonable interpretation of the term "system management information," the cited page and lines of the specification are the only proper guidance, i.e. notification or

event information. The fact that applicant later mentions that such notification or event

information could possibly include things such as critical failure information (see

Specification page 14, line 23-page 15, line 5 – also cited in applicant's arguments in

the appeal brief) does nothing to explicitly define the term as being limited to such

critical failure information. In fact, in applicant's own citations from the argument in the

appeal brief, notification information is again given as an example of system

management information. This is entirely contrary to applicant's argument that

notification information, such as that clearly and explicitly taught by Holt and relied upon

in the rejection, is not system management information.

Further, the problem that applicant is endeavoring to solve does not define terms

used in the claim language. Again, if applicant would like to limit system management

information to only information concerning critical failures of system components, the

examiner suggests such language be added to the claims.

Applicant argues, on pages 16-18 :

" *Holt does not teach that the present and available user has a "responsibility for*

responding" to the incoming message. In contrast, claim 8 recites that the intended

recipient of the system management information has a "responsibility for responding" to

the system management information....Holt makes no reference to a duty or obligation

by a present and available online user to respond to an incoming message."

The examiner respectfully disagrees. The responsibility to respond does not require that a response by made. The claims do not teach a response being made. The responsibility to respond merely means that, if a response were to be made, the recipient of the system management information would be the responder. Whether or not a response is or is not made has no bearing on the responsibility to respond. As an example, if a supervisor were to send a message to an employee instructing said employee to call him regarding a work assignment and the employee neglects to do so, the employee has not responded to the message, but that does not change the fact that the employee is held responsible for responding.

With regard to the Holt reference, it is clearly taught that a recipient of the message (system management information) has registered with the system in order to be notified when a user of interested has become available for communication. It can thus clearly be seen that the user having registered to receive the notification message (system management information) would be the user that would be expected to respond to such notification message, were a response to be made. It is thus necessarily true that the user in question has the responsibility to respond to the message, whether or not a response ever occurs. The latter portion, however, is not included in any claim limitations and, thus, the question of whether or not Holt teaches actually responding is a moot point.
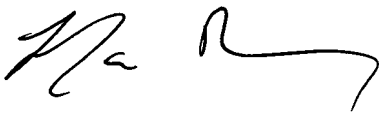
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Marc Duncan

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